

Yasuhiro Suda and Hiroaki Kuno  
Serial No.: 09/526,602  
Filed: March 16, 2000  
Page 6

REMARKS

Claims 21-28 are pending and presented for examination in the subject application, with claim 21 being the sole pending independent claim. Claims 1-20 were previously canceled. Applicants have hereinabove amended claim 21 to place the claim in better form for examination.

Support for the claim amendments may be found in the application at, inter alia, page 4, lines 19-21, and page 13, lines 13-17.

Applicants maintain that no new matter is presented by this amendment. Accordingly, Applicants respectfully request that this Amendment be entered.

Objection To Specification

Page 2 of the December 8, 2003 Office Action states that the specification is objected to because it refers to "drawings" or "views" in the Brief Description of the Drawing on page 4 but there is only one drawing or view present.

The Examiner stated that the specification should be amended to refer to the singular drawing and view.

Applicants have amended the specification hereinabove.

Accordingly, withdrawal of the objection is requested.

Rejection Under 35 U.S.C. §112, first paragraph

On page 2 of the December 8, 2003 Office Action, claims 21-28 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner stated that the claim(s) contains subject matter

Yasuhiro Suda and Hiroaki Kuno

Serial No.: 09/526,602

Filed: March 16, 2000

Page 7

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner also stated that the instant claims have been amended to include a limitation that "... the toner particles containing said thermoplastic resin and coloring agent as main components and having the inorganic particles attached to at least surfaces thereof or containing the inorganic particles ...". The Examiner further stated that the claims present two alternatives for the inorganic particles location: attached to at least surfaces of the toner particles or that the toner particles contain the inorganic particles.

The Examiner stated that the instant specification on page 4 states, "It is desirable for inorganic fine particles to be attached to or impregnated in at least the surface region of the toner particle." The Examiner also stated that on page 13 the specification states, "It is considered reasonable to understand that the inorganic fine particles are attached to or impregnated in at least the surface region of the toner particle so as to produce the ER effect." The Examiner further stated that these appear to be the only passages where the location of the inorganic particles is referenced.

The Examiner stated that these passages clearly form basis for the inorganic particles attached to at least the surface region of the toner particles. The Examiner further stated that the specification does not provide basis for the limitation that the toner particles contain the inorganic particles. The Examiner also stated that this broader limitation provides for the inorganic particles to be present anywhere in the toner particles and in any amount. The Examiner further stated that the inorganic particles could be present in a small number in the surface of the toner or present in the center of the toner

Yasuharu Suda and Hiroaki Kuno  
Serial No.: 09/526,602  
Filed: March 16, 2000  
Page 8

particles with little or no inorganic particles at the surface of the toner. The Examiner stated that the specification is explicit that in order to form the electrorheological fluid the inorganic fine particles must be impregnated in at least the surface region of the toner particle. The Examiner further stated that the specification does not provide any specific meaning of the term "impregnate" and the artisan would the term its usual and customary meaning.

The Examiner stated that Webster's II, New Riverside University Dictionary, states for "impregnate" as relevant definition: "3. to fill throughout or saturate." The Examiner also stated that the other definitions provided are not pertinent as they relate to fertilization processes (1 and 2) or fluids or dyes (4).

The Examiner stated that the specification would be understood by the skilled artisan as describing an invention where the inorganic particles fill throughout or saturate the surface region of the toner particles. The Examiner also stated that this is a different invention from the claimed because the claims do not require the degree or amount of inorganic particles in the surface region described by the specification. The Examiner further stated that this is particularly the case where an electrorheological fluid is present in the produced liquid toner.

The Examiner stated that the claims as presented include new matter and are not described by the specification as filed. The Examiner suggests that the claims be amended to bring them in line with the specification disclosure.

Claim 21 has been amended hereinabove amended claim 21 to place the claim in better form for examination.

Accordingly, Applicants respectfully request reconsideration and

Yasuharu Suda and Hiroaki Kuno  
Serial No.: 09/526,602  
Filed: March 16, 2000  
Page 9

withdrawal of the rejection of claims 21-28 under 35 U.S.C. §112, first paragraph.

In view of the amendments to the claims and remarks hereinabove, Applicants maintain that claims 21-28 are now in condition for allowance. Accordingly, Applicants earnestly solicit the allowance of claims 21-28.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorneys invite the Examiner to telephone them at the telephone number provided below.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

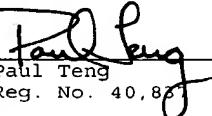
No fee, other than the \$770.00 RCE filing fee, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White, Reg. No. 28,678  
Paul Teng, Reg. No. 40,837  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Paul Teng  
Reg. No. 40,837

March 2, 2003  
Date